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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,167	03/09/2001	Brett Hannigan	EWG-140 US	4738

7590

12/30/2002

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EXAMINER

BHATNAGAR, ANAND P

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,167

Applicant(s)

HANNIGAN ET AL.

Examiner

Anand Bhatnagar

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 and 14 is/are allowed.
- 6) ☒ Claim(s) 1,4,10,11 and 13 is/are rejected.
- 7) ☒ Claim(s) 2,3,5 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

***Response to Arguments***

1. Applicant's amendment paper # 4 filed 10/16/02 has been entered and made of record.
2. Applicant has amended claims 1,6, and 7. Claims 6,9, and 14 were allowed in the original office action. Claims 1-14 are pending.
3. The 35U.S.C. 112, second paragraph, rejection to claims 7 and 8 is withdrawn.
4. Applicant's arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenzel et al. (U.S. patent 4,591,707) in view of Desie et al. (U.S. patent 5,880,760).

Regarding claims 1 and 10: Stenzel et al. discloses a method of watermarking an image (col. 3 lines 46-48 and 65-67) comprising the steps of,

applying a first material on a substrate (col. 3 lines 55-65 and col. 8 lines 41-43, where hallmarks "watermarks" are layered on top of a paper substrate) in a pattern that represents a digital watermark (col. 3 lines 52-55 and col. 4 lines 12-15, where the hallmark has a pattern and is read by machine), said first material being transparent (col. 4 lines 38-40); printing an image on said substrate (col. 4 lines 3-10). Stenzel et al. does not disclose that image areas that are printed on top of the hallmark "watermark" areas will have different characteristics. It would have been obvious to one skilled in the art to combine the disclosure of Desie et al. to the hallmark on paper invention of Stenzel et al. because they are analogous in security marks on paper documents. It is well known and conventional that security marks placed on a paper gives the paper an unlevel surface and an image printed on it will have different characteristics in the areas where the security marks are located as disclosed by Desie et al. (Desie et al., col. 1 lines 15-28). The motivation for the combination would be for any conventional reasons such as the range of signal, the availability of software or hardware, etc.

Regarding claim 11: The method wherein said material is transparent (col. 4 lines 38-40, where it is invisible).

6. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenzel et al. (U.S. patent 4,591,707) in view of Desie et al. (U.S. patent 5,880,760) and Daigneault et al. (U.S. patent 6,334,678).

Regarding claims 4 and 13: The method wherein said image is printed using an ink jet printing process.

Stenzel et al. discloses a watermarking system where a watermark "hallmark" is placed on a paper substrate and an image is printed on top of the hallmark layer. Stenzel et al. does not disclose to use an ink jet printer to print the image onto the paper substrate with the hallmark layer. Daigneault et al. teaches to use a ink jet print to print an image onto a paper substrate that contains a watermark (Daigneault et al., col. 2 lines 15-21). It is a matter of configuration of what type of printer to use to print an image on a paper substrate.

#### ***Allowable Subject Matter***

7. Claims 6,7,8,9, and 14 are allowed.
8. Claims 2,3,5, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. Any inquiry into this communication should be directed to Anand Bhatnagar whose telephone number is 703-306-5914, whose supervisor is Amelia Au whose number is 703-308-6604, group receptionist is 703-305-4700, and group fax is 703-872-9314.

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AB

Anand Bhatnagar

Art Unit 2623

December 21, 2002

A handwritten signature in black ink, appearing to read 'SAMIR AHMED', written over a horizontal line.

**SAMIR AHMED**  
**PRIMARY EXAMINER**